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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,571	02/02/2007	Samir Mitragotri	LA-1279-407/10408871	6636
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Rober Berliner Berliner & Associated 555 W. Fifth Street 31st Floor Los Angeles, CA 90013			EXAMINER LUNDGREN, JEFFREY S	
			ART UNIT 1639	PAPER NUMBER
			MAIL DATE 08/07/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/560,571

Applicant(s)

MITRAGOTRI ET AL.

Examiner

JEFFREY S. LUNDGREN

Art Unit

1639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-52 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-34, are drawn to a method for selecting compositions having certain permeability properties, classified in class 506, subclass 7.
- II. Claim 35, is drawn to a formulation having potent ability to increase permeability, classified in class 506, subclass 13.
- III. Claims 36-38 and 44-46, is drawn to a formulation having a compound(s), wherein the compounds are defined by properties, classified in class 506, subclass 14.
- IV. Claims 39-40, are drawn to formulation comprising a first and second chemical penetration enhancer with potent ability to increase the permeability of skin showing sufficient partitioning of components of said formulation between the stratum comeum of skin and other layers of skin to exhibit low irritation potential, classified in class 506, subclass 15.
- V. Claim 41, is drawn to a composition comprising a first and second chemical penetration enhancer having potent ability to increase the permeability of skin and low irritation potential to enable transdermal delivery of a drug having a molecular weight of at least 500 Da with pharmaceutically acceptable irritation potential, classified in class 424, subclass 400.
- VI. Claim 42, is drawn to a composition comprising sodium laurel ether sulfate and 1-phenyl piperazine having potent ability to increase the permeability of skin and low irritation potential, classified in class 424, subclass 449.
- VII. Claim 43, is drawn to a composition comprising N-lauryl sarcosine and sorbitan monolaurate having potent ability to increase the permeability of skin and low irritation potential, classified in class 424, subclass 449.
- VIII. Claim 47, is drawn to a method for treating a disease that is responsive to administration of a drug comprising applying a formulation to a patient's body surface, classified in class 424, subclass 449.

- IX. Claims 48-49, are drawn to a system for transdermal administration of a drug, classified in class 424, subclass 449.
- X. Claim 50, is drawn to a method for delivering an active component, wherein said formulation has an irritation potential that is less than that of 1.5%wt/vol oleic acid in a vehicle consisting of phosphate buffered saline, the 24- hour synergy value between the first and second chemical penetration enhancer is at least about 2, and the 24-hour conductivity enhancement ratio of said formulation measured with porcine skin is at least about 30, classified in class 424, subclass 449.
- XI. Claim 51, is drawn to a method for screening formulations comprising measuring the irritation potential of the selected compositions whereby formulations providing potent ability to increase the permeability of skin and low irritation potential may be efficiently discovered, classified in class 506, subclass 10.
- XII. Claim 52, is drawn to a method for making a formulation potent, comprising combining at least two materials in a predetermined ratio; whereby a formulation is made, the formulation having a 24-hour porcine skin conductivity enhancement ratio of at least about 30 and an MTT 4-hour cell viability percentage of less than about 15%. classified in class 506, subclass 10.

The inventions are distinct, each from the other because of the following reasons:

Groups I, VIII, X and XII are directed to related methods. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed have different functions and are mutually exclusive. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Groups II-VII, IX and XI, are directed to related products. The related inventions are distinct if: (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are materially

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different from one another, and are mutually exclusive. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

Groups I and II-VII, IX and XI are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process of Group I could be used to make any number of formulations or compound libraries not related to Groups II-VII, IX and XI, and any one of Groups II-VII, IX and XI.

Groups II-VII, IX and XI, and Groups VIII, X and XII, are related as product and process of use, respectively. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case any one of the products could be used in the methods of Groups VIII, X and XII.

Restriction for examination purposes as indicated is proper because all these inventions listed in this action are independent or distinct for the reasons given above and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

For example, Group I relates to a method of identifying compounds, that do not necessarily relate to any of the product groups. Each of the product groups is different, and has different property limitations or chemical components, wherein art relevant to one group would not necessarily be relevant to another group. Each of the methods of use inventions also relies on understanding various compound/library properties, and again, art that relates to the properties of compounds used from one library would not necessarily relate to another library.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of an invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Election of Species

This application contains claims directed to the following patentably distinct species:

- A. *the ability of the samples to increase the permeability* – Applicants should elect one ability of the samples to increase the permeability (e.g., claim 2 or 3);
- B. *a single test membrane* – Applicants are required to elect a single test membrane or tissue such as skin or mucosa (e.g., claims 4, 26, 32, etc.);

- C. *the number of samples in the library* – Applicants are required to elect a value for the number of samples in the library (e.g., claim 12);
- D. *a single penetration enhancer or a single combination of penetration enhancers* – Applicants are required to elect one penetration enhancer, or one combination of multiple penetration enhancers (e.g., claim 13);
- E. *the synergy value* – Applicants are required to elect a single synergy value (e.g., claims 15 and 16); and
- F. *the determination of the irritation potential* – Applicants are required to elect a single determination step of the irritation potential (e.g., claims 19-23).

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be

considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Time for Reply

Applicant is reminded that 1-month (not less than 30 days) shortened statutory period will be set for reply when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program. M.P.E.P. § 809.02(a).

Correction of Inventorship

Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Consideration of Rejoinder

The Examiner has required restriction between product and process claims. Where Applicants elect claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise **include all the limitations of the allowable product claim** will be rejoined in accordance with the provisions of MPEP §

821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR § 1.116; amendments submitted after allowance are governed by 37 CFR § 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR § 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. §§ 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the Examiner before the patent issues. See MPEP § 804.01.

Conclusions

If Applicants should amendment the claims, a complete and responsive reply will clearly identify where support can be found in the disclosure for each amendment. Applicants should point to the page and line numbers of the application corresponding to each amendment, and provide any statements that might help to identify support for the claimed invention (*e.g.*, if the amendment is not supported *in ipsis verbis*, clarification on the record may be helpful). Should Applicants present new claims, Applicants should clearly identify where support can be found in the disclosure.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jeff Lundgren whose telephone number is 571-272-5541. The Examiner can normally be reached from 7:00 AM to 5:30 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James (Doug) Schultz, can be reached on 571-272-0763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jeffrey S. Lundgren/

Patent Examiner, Art Unit 1639